

Application No. 10/664,544
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Docket No. CL-1970 US CIP
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Remarks: General

The claims have been amended by rewriting Claim 23; canceling Claims 1~19 without prejudice to or disclaimer of the subject matter thereof; and adding new Claim 26. No new matter is added by these amendments.

Various words, phrases and textual passages that were not present in the claims as originally filed have been added by amendment to an existing claim, and have been introduced in the new claim. Basis in the specification for those words, phrases and textual passages is as follows:

in Claim 23, support for the recitation as to weight percent may be found on page 25 at line 26;

in Claim 26, support for the recitation as to the metal promoters may be found on page 26 at lines 3~7.

The amendment to Claim 23 is not related to patentability inasmuch as it is made to correct a typographical error.

In view of the cancellation of Claims 1~19, a request and amendment to correct inventorship under 37 CFR 1.48(b) is enclosed, for which the fee stated in §1.17(i) is due. Please charge this fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

A supplemental Information Disclosure Statement ("IDS") pursuant to 37 CFR §1.98 is enclosed, for which the fee stated in §1.17(p) is due by reason of §1.97(c)(2). Please charge this fee to Deposit Account No. 04-1928.

A petition under 37 CFR §1.136 for a two-month extension of time to respond the Examiner's action is enclosed, the fee for which should be charged to Deposit Account No. 04-1928.

By Applicant's calculation, no fees are due by reason of this amendment to the claims. The cancellation of Claims 1~19 has been taken into account in the calculation of the fees. If, however, Applicant's calculation is in error, or if any fee other than or in addition to those mentioned specifically above is required to authorize

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or obtain consideration of this response and the enclosed IDS, please charge such fee to Deposit Account No. 04-1928.

Claims 20~26 are now active in the application. Applicant hereby requests reconsideration and further examination of the application in view of the reasons it has set forth below for allowance of the claims.

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Remarks: Detailed Action

I.

In Item 1, the Examiner has rejected Claim 19 under 35 U.S.C. §101. As Claim 19 has been canceled, Applicant respectfully requests the Examiner to withdraw this rejection.

II.

In Item 2, the Examiner has rejected Claims 1~17 under 35 U.S.C. §112. As Claims 1~17 have been canceled, Applicant respectfully requests the Examiner to withdraw this rejection.

III.

In Item 3, the Examiner has rejected Claims 1~3 under 35 U.S.C. §102 as being anticipated by Jefson, *J. Chem. Ecology*, Volume 9, No. 1 (1983), Pages 159~179; and has rejected Claims 20~25 under 35 U.S.C. §102 as being anticipated by Regnier, *Phytochemistry*, Volume 6 (1967), Pages 1281~1289. Claims 1~3 have been canceled.

On pages 1284~1286, Regnier discloses for use in the hydrogenation of nepetalactone catalysts that may be platinum, platinum oxide or palladium on strontium carbonate. Regnier thus does not teach or suggest anything about the subject matter of Claims 20~26 because those claims are directed to a process in which the hydrogenation occurs in the presence of palladium supported on a catalyst support that is not SrCO₃.

The field of catalysis is so unpredictable that it is not possible to infer from the use of a particular catalytic substance on a particular support that the same catalytic substance would perform the desired function on a different support, or that a different catalytic substance would perform the desired function on the same support. Regnier's disclosure of the use of a palladium on strontium carbonate catalyst thus does not teach or suggest anything about whether palladium on supports other than strontium carbonate would perform the desired catalytic function, as Applicant has discovered that it does.

In view of the distinctions between Regnier the subject matter of Claims 20~25 as discussed above, Applicant respectfully

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requests that the Examiner withdraw the rejection of those claims under 35 U.S.C. §102.

IV.

In Item 4, the Examiner has rejected Claims 4, 5 and 11~18 under 35 U.S.C. §103(a) as being unpatentable over Jefson alone or in view of Eisner, *Science*, Volume 146 (1964), Pages 1318~1320. As Claims 4, 5 and 11~18 have been canceled, Applicant respectfully requests the Examiner to withdraw this rejection.

V.

In Item 5, the Examiner has provisionally rejected Claims 1~19 under 35 U.S.C. §101 as claiming the same invention as that of Claims 1~8, 10~16, 18, 27~37 and 101~155 of copending Application No 10/392,455. As Claims 1~19 have been canceled, Applicant respectfully requests the Examiner to withdraw this rejection.

In view of the foregoing, Applicant submits that all of the Examiner's objections and rejections have been properly traversed, and that the pending claims are in condition for allowance, request for which is hereby respectfully made.

Respectfully submitted,



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